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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.: 10/757,917
Confirmation No. 5126
Filing Date: January 14, 2004
Applicants: DANIEL D. SNOW, et al.
Group Art Unit: 2163
Examiner: Hung T. Vy
Title: METHOD AND ARRANGEMENT FOR
AUTOMATED PROVISION OF SERVICE HINTS
Attorney Docket: 706807US1

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REPLY BRIEF

Pursuant to 37 CFR § 41.41, this reply brief is submitted in response to the Examiner's Answer mailed January 22, 2010 and supplements the Appeal Brief filed November 24, 2009.

706807US1

Ser. No. 10/757,917

TABLE OF CONTENTS

Application No.: 10/757,917	1
Confirmation No. 5126	1
I. STATUS OF THE CLAIMS	3
II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	4
III. ARGUMENTS	5
A. Rejection under 35 U.S.C. § 102(b) over U.S. Pub. No. 2003/0055812 ("Williams")	5
1. Claims 1, 5-6, 12 and 16-17	5
B. Rejection under 35 U.S.C. § 103(a) over U.S. Pub. No. 2003/0055812 ("Williams") in view of U.S. Pub. No. 2002/0156692 ("Squeglia")	7
1. Claims 2-4, 7, 10-11 and 13-14	7
C. Rejection under 35 U.S.C. § 103(a) over Williams in view of Squeglia and U.S. Pub. No. 2004/0010578 ("Demetriades")	7
1. Claims 9	7
D. Rejection under 35 U.S.C. § 103(a) over Williams in view of Squeglia and U.S. Pub. No. 2002/0116316 ("Griffiths")	8
1. Claims 8 and 15	8

706807US1

Ser. No. 10/757,917

I. STATUS OF THE CLAIMS

Claims 1-17 stand rejected and are the subject of this Appeal.

706807US1

Ser. No. 10/757,917

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed are:

1. Anticipation of claims 1, 5-6, 12 and 16-17 under 35 U.S.C. §102(e) by Williams et al. (U.S. Application Publication No. 2003/0055812 A1) (hereinafter Williams);
2. Unpatentability of claims 2-4, 7, 10-11 and 13-14 under 35 U.S.C. §103(a) over Williams in view of Squeglia et al. (U.S. Application Publication No. 2002/0156692 A1) (hereinafter Squeglia);
3. Unpatentability of claim 9 under 35 U.S.C. §103(a) over Williams and Squeglia in view of Demetriades et al. (U.S. Application Publication No. 2004/0010578) (hereinafter Demetriades); and
4. Unpatentability of claims 8 and 15 over Williams and Squeglia in view of Griffiths (U.S. Application Publication No. 2002/0116316) (hereinafter Griffiths).

706807US1

Ser. No. 10/757,917

III. ARGUMENTS

A. Rejection under 35 U.S.C. § 102(b) over U.S. Pub. No. 2003/0055812 ("Williams")

1. Claims 1, 5-6, 12 and 16-17

In rejecting claim 1, the Examiner alleges that Williams discloses "inputting a description of the problem" relying on "[t]he user inserts data from the my notes column 399 that is sufficiently large to contain most detailed repair/replacement notes that may be encountered" from Paragraph [0072] of Williams (see page 4 of the Office Action). The Examiner also alleges that Williams discloses inputting "at least one hint for assisting in diagnosing the problem" relying on "[t]he user inserts data from the my notes column 399 that is sufficiently large to contain most detailed repair/replacement notes that may be encountered" from Paragraph [0072] of Williams (see page 4 of the Office Action). Appellants respectfully note that Paragraph [0072] of Williams and the corresponding description does not disclose both "inputting a description of the problem" and inputting "at least one hint for assisting in diagnosing the problem", as claim 1 recites. Instead, Paragraph [0072] of Williams discloses only inputting detailed repair and replacement notes following repair or replacement of a part.

In other words, claim 1 recites inputting a description of a problem and then inputting a hint for assisting in diagnosing the problem. Even if the "notes" of Williams disclosed inputting a description of a problem, they do not disclose inputting "at least one hint for assisting in diagnosing the problem." No where does Williams disclose that the "notes" are input as hints for assisting in diagnosing the problem. Instead, the "notes" are merely provided to inform repair personnel, the vehicle owner or subsequent vehicle owners exactly what type of repairs were performed on the vehicle (see e.g. Paragraph [0073] which discusses the "notes" use as a maintenance logbook). Simply knowing what repairs are performed on the vehicle will not provide a hint for assisting in diagnosing the problem because the "problem" in Williams, i.e. the repair/replacement of a part is already being conducted, and the "notes" simply provide information related to that fact.

706807US1

Ser. No. 10/757,917

The "notes" will not provide any diagnostic assistance and are simply provided to inform of repairs/replacements of parts.

Claim 1 therefore recites elements not disclosed in Williams.

Further, in rejecting claim 1, the Examiner alleges that Williams discloses that "the at least one hint includes a file that includes a suggestion from an engineering group for resolving at least one of a failure mode of the at least one component part and a repair related to the at least one component part" relying on "repair person" and "industry notes 398" to disclose the engineering group of claim 1 (see page 4 of the Office Action).

However, the "industry notes 398" clearly do not correspond to a hint. Appellants point out that the Examiner has alleged that the "my note column 399" of Williams corresponds to the location for the so called hint of Williams to be entered. However, here the Examiner alleges that the "industry notes 398" correspond to the hint of claim 1. In other words, both the "my notes column 399" and the "industry notes 398" cannot both correspond to the hint of claim 1. The Examiner therefore also alleges that a "user or repair person" can insert their notes on the part by typing their notes in the "my notes column 399". However, a user or a repair person in Williams are clearly not intended to be an engineering group, as claim 1 recites. Instead, the user or repair person in Williams correspond to individuals such as vehicle owners or repair personnel that provide information related to a repair performed on a vehicle (see e.g. Paragraph [0023] of Williams). Williams makes no mention of the users or repair personnel being engineering groups. Further, to the extent that Williams discloses industry notes 398, the industry notes 398 do not correspond to hints, which the Examiner has already alleged correspond to the "my notes column 399".

The industry notes of Williams are provided independent of any information included in the "my notes" column. The industry notes are simply available information on parts, which is typical in a parts monitoring system. In contrast, the "my notes" are input by a user such as a repair person working on a vehicle.

706807US1

Ser. No. 10/757,917

The Examiner is therefore picking only so much of portions of Williams that support his position while ignoring what the reference fairly teaches.

The Court of Appeals for the Federal Circuit has recently stated: "We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102... [D]ifferences between the prior art reference and a claimed invention, however slight, invoke the question of obviousness, not anticipation." *Net Money/IN Inc. v. VeriSign Inc.*, 88 USPQ2d 1751, 1759-1760 (Fed. Cir. 2008).

Therefore, claim 1 is allowable for at least these reasons. Claim 12 is allowable for at least similar reasons as claim 1. Claims 5-6, 8 and 16-17 ultimately depend from claims 1 and 12 and are allowable for at least similar reasons.

B. Rejection under 35 U.S.C. § 103(a) over U.S. Pub. No. 2003/0055812 ("Williams") in view of U.S. Pub. No. 2002/0156692 ("Squeglia")

1. Claims 2-4, 7, 10-11 and 13-14

Squeglia does not remedy the deficiencies of Williams with respect to claims 1 and 12, from which claims 2-4, 7, 10-11 and 13-14 depend. Therefore, claims 2-4, 7, 10-11 and 13-14 are in condition for allowance for at least similar reasons as claim 1.

C. Rejection under 35 U.S.C. § 103(a) over Williams in view of Squeglia and U.S. Pub. No. 2004/0010578 ("Demetriades")

1. Claims 9

Demetriades does not remedy the deficiencies of Williams in view of Squeglia with respect to claim 1, from which claim 9 depends. Therefore, claim 9 is in condition for allowance for at least similar reasons as claim 1.

706807US1

Ser. No. 10/757,917

D. Rejection under 35 U.S.C. § 103(a) over Williams in view of Squeglla and U.S. Pub. No. 2002/0116316 ("Griffiths")

1. Claims 8 and 15

Griffiths does not remedy the deficiencies of Williams in view of Squeglla with respect to claim 1, from which claims 8 and 15 depend. Therefore, claims 8 and 15 are in condition for allowance for at least similar reasons as claim 1.

706807US1

Ser. No. 10/757,917

CONCLUSION

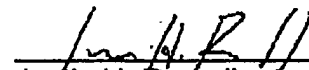
Appellants respectfully request the Board to reverse the Examiner's rejection of the claims on appeal.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

Date: March 8, 2010

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